REMARKS

To further prosecution of the present application, Applicant has cancelled herein Claims 1-54 without prejudice to the subject matter disclosed therein, and has added herein new Claims 55-94. New Claims 55-94 have antecedent basis and do not add new subject matter to the application. Applicant respectfully requests reconsideration.

Claim Rejections Under 35 U.S.C. § 101

In the Office Action of September 16, 2004, the Examiner rejected previously pending claims 1-54 because the claimed inventions were directed to nonstatutory subject matter. The Examiner indicated that the inventions are not in the technological arts because they are not of a computer method or system.

The foregoing amendment has cancelled herein Claims 1-54 and has added herein Claims 55-94. Applicant respectfully submits Claims 55-94 are directed to statutory subject matter under 35 U.S.C. § 101, and provide a practical application in the technological arts. Applicant respectfully requests reconsideration and withdrawal of this rejection in light of the foregoing amendments and discussion below. The invention claimed in new independent Claims 55, 79 and 81 provides a practical application in the technological arts, including an integrated computer system and a method performed at least partially by a programmed computer to plan for, implement and administer a retirement benefit program. The retirement benefit program includes at least one guaranteed life-dependent retirement benefit to provide guaranteed income to at least one person using the personal financial assets of the person.

However, providing a practical application in the technological arts is not a requirement under U.S. patent law. 35 U.S.C. § 101 states:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

The Federal Circuit states, in it's decision in *State Street Bank & Trust Co. v. Signature Financial Group*, 149 F.3d 1368, 1372 (Fed Cir. 1998):

> The plain and unambiguous meaning of § 101 is that any invention falling

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within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in title 35, i.e., those found in §§ 102, 103 and 112, second paragraph. The repetitive use of the expansive term "any" in § 101 shows Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in § 101. Indeed, the Supreme Court has acknowledged that Congress intended § 101 to extend to "anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980); *see also, Diamond v. Diehr*, 450 U.S. 175, 182 (1981). Thus, it is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations. *See, Chakrabarty*, 447 U.S. at 308 ("We have also cautioned that courts should not read into the patent laws limitations and conditions which the legislature has not express . . ."
[A]fter *Diehr* and *Alappat*, the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter. *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557.

The *State Street Bank* decision involved subject matter directed to problems of administering a group of mutual funds. The patent at issue in *State Street Decision* includes method claim 1 that produces a useful, concrete and tangible result. Even if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss, a useful result renders the method statutory subject matter. Applicant respectfully submits the claimed invention of Claims 55-94 produces useful, concrete and tangible results. Specifically, each of Claims 55, 79 and 81 produces a novel and flexible retirement benefit program including at least one guaranteed life-dependent retirement benefit.

Although Claims 55-94 include a computer system, a server and various server components, as noted, inclusion of a computer system, a server and various server components into a claim that otherwise produces a useful, concrete and tangible result is not a requirement for the claim to recite statutory subject matter.

In addition to the *State Street Bank* decision, MPEP 706.03(a) gives examples of subject matter that are not patentable under 35 U.S.C. § 101, including printed matter, a naturally occurring article, and a scientific principle. The retirement benefit program of Claims 55-94 is not covered by these examples and therefore constitutes patentable subject matter.

Double Patenting

Claims 1, 14 and 30 were rejected under the judicially created doctrine for obviousness-type double patenting as being unpatentable over Claim 1 of U.S. 5,933,815 issued to Golden ("Golden"). The Examiner indicates in the Action that although the conflicting Claim 1 is not identical to Claims 1, 14 and 30, the Claims are not patentably distinct from each other because an ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to combine the teachings of the patent with the practitioner's own knowledge of the art to produce the claimed invention. Claims 1, 14 and 30 are cancelled herein.

Applicant respectfully submits new Claims 55-94 are patentable over Golden. Golden discloses a computerized method and system for acquiring retirement benefits while maintaining a measure of liquidity of assets. The object of the method and system is to maintain at least sufficient partial liquidity based on withdrawals from assets and distributions of purchased retirement benefits. The claimed invention of new Claims 55-94 enables managing guaranteed benefit income rather than managing liquidity, as will become apparent from the discussion provided below.

Patentability of Claims 55-94

New Claims 55-78 are directed to an integrated computer system to plan for, implement and administer a retirement benefit program that includes at least one guaranteed life-dependent retirement benefit to provide a guaranteed income to at least one person using one or more personal financial assets of the person. New Claims 79-80 are directed to an integrated computer system to plan for, implement and administer the retirement benefit program, as described above, including at least one simulation component to provide a plurality of sample benefit programs for the person to consider. New Claims 81-94 are directed to a method performed at least partially by a programmed computer for planning for, implementing and administering a retirement benefit program, as described above. Applicant respectfully submits new Claims 55-94 are patentable in view of the prior art references cited in the Office Action dated September 16, 2004. More particularly, the cited prior art references, alone or in any of the various

combinations cited in the Office Action, do not teach or suggest all of the recitations of the Claims. In addition, the cited prior art references fail to provide the motivation for one having ordinary skill in the art to modify or combine the cited references to achieve the claimed invention.

The cited prior art references are discussed below with respect to the differences between the prior art inventions disclosed and the claimed invention. Further, the cited combinations of prior art references are discussed with respect to the patentability of the invention claimed in new Claims 55-94.

A.   General Overview of Prior Art Systems and Methods and The Claimed Invention

Prior Art Overview

Currently, retirees and individuals investing for retirement have access to a plurality of products that provide for the many financial and other needs that may arise. For example, equity mutual funds can provide potential for market appreciation, while on the other hand life annuities can offer retirees a fixed annual income for life. Unfortunately, many retirees and individuals still do not achieve their retirement objectives due to the fact that individuals do not fully understand the nature of risks involved, whether it be market risk or actuarial risk.

Moreover, aside from the often complex aspects of purchasing an insurance or investment product, the currently offered insurance products do not provide the flexibility to alter the purchased benefits and income once the product has been purchased or "locked-in." For instance, a change in health of a retiree or his/her spouse may make such a "locked-in" purchase an expensive one. Finally, by locking in one's assets into a guaranteed insurance product, clients lose out on the potentially higher yields of the stock market or other investment product. Meanwhile, while investment products offer flexibility , they do not provide protection against actuarial risks.

Thus, what is needed is an integrated individual retirement system and method that offers the flexibility to change benefit income as needs change while moving to a secure retirement stage with guaranteed lifetime income. This system and method should

further address the confusing elements of insurance and actuarial products so that individuals can properly obtain a flexible benefit program that most nearly satisfies their retirement objectives and changed circumstances over time.

Summary of Invention

Prior art systems and methods, including the systems and methods disclosed in the prior art references cited in the September 16, 2005 Office Action, do not provide for a retirement benefit program as claimed in Claims 55-94. In particular, prior art systems and methods do not provide for a retirement benefit program including one or more guaranteed life-dependent retirement benefits that provides flexibility to an individual with respect to altering or changing the benefit program to modify the income such program provides and to thereby ensure benefit income sufficient to satisfy the individual's retirement objectives and changing circumstances over time. In addition, prior art systems and methods do not focus on managing income during an individual's or retiree's lifetime, but rather focus solely on managing the accumulation of retirement assets.

More specifically, prior art systems and methods are not flexible and tend to "lock-in" or render illiquid those personal financial assets an individual uses to purchase, for instance, a guaranteed insurance product. With assets locked-in to a guaranteed retirement benefit, an individual can miss potential investment returns if at least a portion of the individual's financial assets had remained in an investment product that would gain from higher stock market yields. Most guaranteed insurance products that prior art systems and methods provide have the inherent characteristic of fulfilling a single fixed objective, such as a lifetime income or a guaranteed death payment, without any provisions for flexibility or adjustment of the benefit income in response to an individual's needs or desires.

For example, a retiring individual, who has accumulated personal funds, such as a qualified IRA, would need to decide whether to purchase a guaranteed insurance product that would provide a lifetime income or to take distributions from the IRA account that is, for instance, invested in mutual funds. In the first case, the individual would apply the

IRA assets to purchase the insurance product and thereby forego any potential investment returns as a result of stock market gains had at least a portion of the funds remained in the IRA account. In the other case, the individual would take distributions from the IRA and run the risk of decreasing or depleting his/her income as such distributions decrease or run out over time.

The systems and methods of the claimed invention recited in new Claims 55-94 integrate planning, implementation and administration processes with available investment and insurance products to form a personalized retirement benefit program. More particularly, the claimed systems and methods provide a retirement benefit program that is easily modified to adjust the benefit income and focuses on managing benefit income as opposed to accumulating assets. In effect, the claimed systems and methods plan for, implement and administer a retirement benefit program that includes at least one guaranteed life-dependent retirement benefit using a person's personal financial assets. The claimed systems and methods gradually purchase a guaranteed life-dependent retirement benefit over an allocation period using a portion of personal financial assets of the person, while allowing a remainder of such assets to remain invested in an investment vehicle, such as a mutual fund. By gradually purchasing the retirement benefit, the systems and methods of the claimed invention allow the person to control the effects of the volatility of the invested assets with respect to stock market returns, such as in the case of mutual funds, on the income the person receives. In this manner, the person has at least some control of the income the person can anticipate receiving from the retirement benefit and from the invested assets. The systems and methods of the claimed invention plan for, implement and administer a retirement benefit program that a person can alter or vary during his/her life to provide sufficient income as, for instance, guaranteed lifetime income, survivor income, caregiver benefits, legacy income benefits, lump sum legacy benefits, and long term care benefits.

In addition, the systems and methods of the claimed invention perform actuarial valuations of the person's guaranteed life-dependent retirement benefits, which prior art systems and methods typically do not perform for an individual's benefits, but rather at a group level such as, for instance, for a defined benefit pension fund. Actuarial valuations

provide a current value of each retirement benefit the person has purchased to date. Added to a market value of the person's financial assets, such as his/her mutual funds, the systems and methods of the claimed invention provide *a total current value* or a total program value that helps the person to gauge whether the benefit income from the current retirement benefits will be sustainable for life and provide sufficient income. The systems and methods of the claimed invention calculate the total current value for a current date and for future intervals of the allocation period during which the one or more retirement benefits are gradually purchased.

In addition, the systems and methods of the claimed invention calculate *a target benefit payment value* for a current date and for future intervals of the allocation period. The target benefit payment value represents a benefit payment available to a person should the systems and methods of the invention accelerate the allocation period by using the person's total current value, or, in other words, the current value of the retirement benefit purchased to date and the market value of his/her assets, to purchase the remainder of the retirement benefit.

The total current values and *the target benefit payment values* of the claimed invention provide the person with information about current and future benefit income that enables the person to gauge whether the income generated from the retirement benefit program will be sustainable for life and provide sufficient income. If a person needs to change or wishes to change the potential benefit income, the systems and methods of the claimed invention are adapted to respond to changes to the retirement benefit program the person specifies, e.g., increasing or decreasing one or more retirement benefits being gradually purchased, to thereby modify or alter the income the retirement benefit program provides. In this way, the systems and methods of the invention claimed in Claims 55-94 enable a person to easily modify his/her established retirement benefit program in order to manage benefit income currently and into the future.

B.   Differences Between Cited Prior Art References and Claimed Invention -
      Prior Art References Do Not Teach or Suggest All Claim Limitations of
      New Claims 55-94

(1)   Tarbox

Tarbox discloses a system and method generally related to an investment program that eliminates the inherent economic conflict of interest in traditional benefit plan programs that exists between an entity providing investment advice and an entity providing investment management. Entities that are most capable of providing investment advice to individuals are the same entities that traditionally manage the investments of such individuals. Typically, investment managers receive most of their compensation as a percentage of assets managed, with such percentages varying according to the nature of risk associated with the investments managed. For example, a manager of an international equity fund receives a high percentage of managed assets while a manager of a domestic bond fund receives a low percentage of the same managed assets. The system and method of the invention disclosed in Tarbox essentially provides investment advice and assistance independent from the investment management entity. By separating the investment advice entity from the investment management entity, the system and method provide compensation for investment advice independent of the investment management, and insures that the investment manager has access to investments of a benefit plan and not those investments of individuals. (col. 1, lines 5-15, 40-47, and 55-58).

Fig. 1 of Tarbox illustrates a representative investment system and method. The system and method (10) provides professional asset allocation advice services (12) to individual participants (14) in Benefit Plans that participants use to allocate or designate their Benefit Plan account balances to one or more Trusts (20, 22, 24, 26). Such Trusts are tailored to a participant's individual risk tolerances and retirement funding needs. (col. 3, lines 21-28).

As described in Tarbox, "Benefit Plans" include 401(k) plans, Keogh plans and IRAs that allow Benefit Plan participants to self-direct their assets to certain investment vehicles or Trusts (20, 22, 24, and 26). (col. 3, lines 42-46). "Trusts" as described in Tarbox include a commingled Trust, a money market fund, a guaranteed investment contract or similar vehicle. Each Trust holds shares of a plurality of mutual funds of an

open-ended investment company. (col. 3, lines 55-61). "Benefit Plan participants" described in Tarbox include individual participants in the aforementioned plans. As an example, a Benefit Plan participant designates his/her assets from a Benefit Plan, such as a 401K plan administered by the participant's employer, to one or more Trusts (20, 22, 24, 26), such as a money market fund.

Under prior art systems and methods, Benefit Plan participants typically designate their 401K, Keogh or IRA account balances to, for instance, one or more groups of mutual funds to earn investment returns. Asset designation or allocation, therefore, is typically self-directed by individual Benefit Plan participants either without receiving investment advice or with investment advice that is provided by the same entity that also manages the investment or the mutual funds into which assets are allocated.

The system and method of Tarbox provides the Benefit Plan participant with investment assistance and advice independent of the investment management entity. The system and method of Tarbox is directed to attaining an appropriate asset allocation to a plurality of mutual funds or one or more Trusts (20, 22, 24, 26) depending upon a Benefit Plan participant's stage of life and his/her risk tolerance. The system and method allows Benefit Plan participants to be informed when self-directing their Benefit Plan account balances. Each Trust is designed to accommodate different investment strategies by varying the proportions of mutual fund shares in each Trust. For instance, a Trust can be aggressively structured with mutual funds that invest in equities, or can be conservatively structured with mutual funds that invest in fixed income instruments. (col. 4, lines 1-3; col. 4, line 60 to col. 5, line 6).

As shown in Fig. 2, the system and method of Tarbox employs a work sheet (40) to elicit information from individual Benefit Plan participants necessary for an investment advisor (32) to recommend a Trust most appropriate for the individual participant. (col. 4, lines 26-31). The work sheet (40) is available to participants in many forms including, for instance, a hard copy with written instructions or an electronic copy via an Intranet or the Internet. (col. 6, lines 47-53).

In general, Tarbox does not teach or suggest a computer system for implementing and administering a retirement benefit program to provide a person with a guaranteed

lifetime income as recited in independent Claim 55. In particular, Tarbox discloses a system and method only for advice and assistance in funding investment vehicles or Trusts (20, 22, 24 and 26) that hold shares of a plurality of mutual funds. Although Tarbox uses the terms "Benefit Plan" or "self-directed Benefit Plan," "Benefit Plan" in the patent disclosure refers to an asset vehicle, such as a 401K plan, a Keogh plan and an IRA. Participants use such an asset vehicle to purchase an investment vehicle, such as a group of mutual funds, rather than a retirement benefit program the computer system of Claim 55 plans for, implements and administers including at least a first guaranteed life-dependent retirement benefit, such as, for instance, an annuity product, that provides lifetime income benefits to at least one person's survivor(s). Tarbox discloses an advice and assistance system and method for designating Benefit plan assets, such as a 401K, to an investment vehicle, such as mutual funds, to earn additional investment returns. In other words, Tarbox essentially discloses a system and method for providing advice with respect to transferring assets from one asset vehicle to another asset vehicle. The computer system of Claim 55 may use all or a portion of such Benefit Plan assets to implement and administer the retirement benefit program. Tarbox discloses only a part of the solution.

More particularly, Tarbox does not teach or suggest at least *the allocation component* and *the controller* of the computer system, as recited in Claim 55. The allocation component is:

> *adapted to execute at selected intervals of an allocation period in accordance*
with *at least a first set of instructions an allocation of a portion of funds corresponding to at least one asset vehicle containing one or more personal financial assets owned by the person towards purchasing one or more fractions of at least a first guaranteed life-dependent retirement benefit that provides one or more income benefit payments to the person to thereby gradually purchase the first retirement benefit during the allocation period while allowing a remainder of the funds corresponding to the asset vehicle to generate investment returns, the first set of allocation instructions including at least information specified by the person.*

The controller is:

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> *adapted to calculate as of a current date: (i) a total current value representative*
> *of a sum of a current value of the first retirement benefit purchased to date based*
> *on actuarial valuations and a market value of the asset vehicle, and (ii) a target*
> *benefit payment value representative of a benefit payment available to the person*
> *if the allocation component immediately accelerates the allocation period by*
> *executing an allocation of funds corresponding to the total current value towards*
> *purchasing a remainder of at least the first guaranteed life-dependent retirement*
> *benefit, and to calculate for each future interval of the allocation period: (i) a*
> *total current value and (ii) a target benefit payment*

In contrast to the allocation component recited in Claim 55, Tarbox does not teach or suggest *the allocation component adapted to execute . . . in accordance with a first set of instructions . . . including at least information specified by the person . . . an allocation of a portion of funds . . . towards purchasing . . . at least a first guaranteed life-dependent retirement benefit that provides one or more income benefit payments . . . while allowing a remainder of funds . . . to generate investment returns during an allocation period.* Rather, Tarbox discloses an advice and assistance system and method for transferring funds from one asset vehicle, e.g., a 401K plan, to another asset vehicle, e.g., a Trust including a mix of mutual funds. Tarbox does not teach or suggest the allocation component of the computer system of Claim 55 adapted for *purchasing one or more fractions of at least a first guaranteed life-dependent retirement benefit that provides one or more income benefit payments.* A Trust including a mix of mutual funds, as disclosed in Tarbox, cannot provide a guaranteed life-dependent retirement benefit that provides one or more income benefit payments.

In addition, Tarbox does not teach or suggest the controller as claimed in Claim 55 being *adapted to calculate the total current value and the target benefit payment value for each of future intervals of the allocation period.* The total current values of future intervals of the allocation period that the controller calculates, and the server provides to the person for consideration, include information with respect to the future values of the person's asset vehicle and of the first guaranteed life-dependent retirement benefit being

gradually purchased. (Total current value of future interval equals the sum of current value of retirement benefit purchased to date and market value of asset vehicle). In addition, the target benefit payment values of future intervals of the allocation component the controller calculates, and the server provides to the person for his/her consideration, include information with respect to the income benefit payments available to the person if the allocation component immediately accelerates the allocation period and purchases the remaining portion of the first guaranteed life-dependent retirement benefit.

The total current values and the target benefit payment values of future intervals of the allocation period provide the person with information with respect to future guaranteed income benefit payments. The recalculated total current values and the recalculated target benefit payment values of future intervals of the allocation period also provide the client with information with respect to a guaranteed retirement income relative to the at least one change to the retirement benefit program.

Further, Tarbox does not teach or suggest the allocation component being further adapted:

> *. . . to alter the allocation of funds towards achieving the recalculated total current values and the recalculated target benefit payment values in accordance with at least a second set of instructions including at least information specified by the person based on the at least one change to the retirement benefit program.*

The computer system of Claim 55 is thereby adapted to provide a number of "what-if" scenarios using *the change information* the controller employs to recalculate these future values. As illustrated in the table shown in Fig. 5a of the present application, the total current value (510), which as mentioned is a sum of the market value of the asset vehicle and the current value of the benefit purchased to date, is displayed for selected intervals, or Years 1-16, of the allocation period. In addition, Fig. 5a displays the target benefit payment (512) for intervals of the allocation period. If the retirement benefit program were at Year 1, the illustrated values for Years 2 thru 16 would be total current values and target benefit payment values of future intervals of the allocation period. If the controller recalculates these future values based on at least change information to the

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retirement benefit program specified by the person, the future values would change reflecting the effect the at least one change to the retirement benefit program. The computer system server of Claim 55 is adapted to provide these values for future intervals of the allocation period, as well as the recalculated values for such future intervals, to the person for consideration of the effects of the change to the retirement benefit program.

The controller of Claim 55, in particular, is adapted to recalculate the total current values and the target benefit payment values for future intervals of the allocation period *based on change information received from at least the remote client computer including at least one change to the retirement benefit program specified by the person.* For instance, at least one change to the retirement benefit program would include the person specifying a second guaranteed life-dependent retirement benefit for the retirement benefit program. In this case, the allocation component would allocate assets towards gradually purchasing both the first and the second retirement benefit during the allocation period. In addition, the controller would recalculate the total current values and the target benefit payment values for future intervals of the allocation period based on the change information to provide recalculated total current values and target benefit payment values for future intervals.

The server provides the recalculated total current values and the recalculated target benefit payment values of future intervals of the allocation period to the person for consideration. These recalculated future values provide information with respect to the change in the retirement benefit program, e.g., the allocation component executing a gradual purchase of the second guaranteed life-dependent retirement benefit during the allocation period, should the person choose to implement the change. The person can also use these recalculated future values to determine whether the retirement benefit program is likely to provide sufficient guaranteed lifetime income in view of the person's present and anticipated future needs and living circumstances because of the change in the retirement benefit program. In addition, the person can use the recalculated values to determine whether the computer system should implement the change to the program.

The retirement benefit program the computer system of Claim 55 plans for, implements and administers provides for alterations to the allocation of assets towards

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gradually purchasing different guaranteed lifetime retirement benefits during an allocation period, and/or towards purchasing reduced and/or increased amounts of guaranteed lifetime benefits, to thereby alter or change the guaranteed lifetime income the retirement benefit program provides. The computer system of Claim 55 thereby plans for, implements and administers a retirement benefit program with flexibility in terms of altering or adjusting a guaranteed lifetime income in response to the person's changing or unforeseen circumstances, as well as market performance and interest rates.

Further, prior art systems and methods like Tarbox do not provide for *a controller of a computer system adapted to calculate as of a current date . . . and for future intervals of the allocation period the total current values* and *the target benefit payment values*, as discussed above, . . . and *to recalculate total current values* and *target benefit payment values for future intervals based on . . . at least one change to the retirement benefit program specified by the person.*

Clearly, Tarbox does not teach or suggest at least the controller and the allocation component of the computer system, as recited in Claim 55.

(2)   Jones

Jones discloses a method of financial product selection that simulates return scenarios for optimized portfolio allocations. The method of Jones seeks to overcome the drawbacks of many prior art programs including investment software packages that allow a user to manipulate economic conditions rather than requiring the user to focus on his/her decisions concerning investment risk, savings rate and retirement age within the context of realistic economic assumptions. In addition, many investments such as mutual funds cannot be easily categorized into any one generic asset class category and are typically a mix of many different asset classes that makes it difficult for an individual to select an actual combination of financial products that meets an allocation suggested by such programs. Advice provided by such software packages can be misleading and impossible to implement in practice. (col. 1, lines 38-44; col. 1, line 61 - col. 2, line 2).

In the Jones financial advisory system a method of financial product selection is provided that includes outcome-based risk profiling whereby a user can focus on his/her

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own decisions regarding investment risk while interactively observing the impact of those decisions on the range of possible investment outcomes. The system aims to create a feasible portfolio that incorporates the preferences of an individual for different financial product combinations and optionally one or more parameters specific to the individual. (col. 2, lines 16-25). The system can also accomplish plan monitoring on an ongoing basis to alert the user if their financial goals are likely to fall short. (col. 2, lines 36-40).

"Financial products" as used in Jones refer to a legal representation of the right to provide or receive future benefits, e.g., a security. (co. 3, lines 36-39). Projected returns of a plurality of asset classes, such as mutual funds, comprise a model that spans a range of typical investment products. The model is a factor model that is a return-generating function that attributes the return on a financial product, e.g., a security, to the financial product's sensitivity to common economic factors. After generating future scenarios for the factor model, available financial products are mapped onto the factor model. The financial products may include a specific set of mutual funds offered by an employer sponsored 401(k) program. The financial products are mapped on the factor model by decomposing returns of the financial products to asset classes employed by the factor model. In doing so, the system determines the constraints on exposures to different asset classes. This relationship between a user's financial products and the factor model enables the system to generate forward-look investment scenarios. (col. 3, line 47 - col. 4, line 21).

As shown in Fig. 3 of Jones, the advisory system includes various analytic modules including an optimization module (340) and a simulation module (330). The optimization module calculates the set of financial products under a set of constraints defined by the user, such as intermediate goals including buying a house or putting a childe through college, as well as bounds on asset class and/or specific financial product holdings. The optimization module takes into account the impact of future contributions and expected withdrawals on the optimal asset allocation, and the forecasts of expected returns for factors or stocks. (col. 10, line 54 - col. 11, line 2).

The simulation module processes raw simulated return scenarios into statistics, such as the probability of attaining a certain goal or the estimated time required to reach a

certain level of assets with a certain probability. The simulation module provides the user with the ability to interact with the portfolio scenarios generated by the optimization module. (col. 11, lines 7-19).

Although the advisory system of Jones includes the simulation module that allows a user to interact with various portfolio or investment scenarios, the system, nor any of its modules, does not teach or suggest *a controller adapted to calculate as of a current date . . . and for each future interval of the allocation period . . . (i) a total current value . . . and (ii) a target benefit payment value . . . and further adapted to recalculate for each future interval of the allocation period a recalculated total current value and a recalculated target benefit payment value based on . . . at least one change to the retirement benefit program specified by the person.* In particular, Jones does not teach or suggest the total current values and the target benefit payment values as of a current date and for future intervals of a real-life or actual retirement benefit program. Nor does Jones teach or suggest the recalculated total current values or the recalculated target benefit payment values for future intervals of the allocation period based on at least one change to the retirement benefit program, as such values are claimed in Claim 55.

Further, Jones does not teach or suggest gradually purchasing *at least one guaranteed life-dependent retirement benefit* for a retirement benefit program that provides a guaranteed lifetime income.

(3)   Cooperstein

Cooperstein discloses a method and a computer-implemented system for determining funding data representing tangible annuity contract values across a life period of a potential or existing annuity contract, and includes payout data representing tangible contract payout values paid to an annuity contract holder on a payout schedule. More specifically, a computer-implemented system of Cooperstein includes, *inter alia*, a programmed processor. The programmed processor processes annuitant data (e.g., name, age, date of birth, gender, etc. of annuitant), annuity contract specification data (e.g., whether annuity contract is an individual, rated or joint coverage plan, type of death benefit, the mode of payout, etc.), annuity contract rate data (e.g., guaranteed mortality,

interest, and option benefit cost rates as of the contract data, and any declared rates guaranteed for an initial period, etc.) and annuity contract purchase value data (e.g., the amount of purchase payment value to be deposited into the annuity contract and the potential or actual purchase date). (col. 4, lines 47-67; col. 11, line 41- col. 12, line 18).

The processor physically transforms the annuity contact purchase value data to encoded funding data representing tangible annuity contract values. In addition, the processor processes the aforementioned annuity data to generate payout data representing tangible contract payout values. The computer-implemented system of Cooperstein therefore provides at selected dates of the life period of a potential or existing annuity contract tangible annuity contract values, and generates at specific times during the life period tangible contract payout values.

However, in contrast the calculations the controller of Claim 55, Cooperstein does provide at least recalculating such funding data or annuity contract values and contract payout values. More specifically, the method and the computer-implemented system of Cooperstein do not include at least *a controller . . . adapted to calculate as of a current date . . .* [and] *for each future interval of the allocation period a recalculated total current value and a recalculated target benefit payment based on at least change information . . . including at least one change to the retirement benefit program*, as those future values are claimed in Claim 55. Cooperstein cannot provide for changes to the annuity contract values or payout values paid to the contract holder.

Indeed, Cooperstein does not teach or suggest *a controller adapted to calculate . . . a total current value representative of a sum of a current value of at least a first retirement benefit and a market value of at least one asset vehicle.* Cooperstein also does not consider nor provide for in its processor calculations a market value of the annuity control holder's assets that remain in an asset or investment vehicle separate from the annuity contract as of a current date and for future intervals of an allocation period.

In addition, Cooperstein does not consider nor provide for in its processor calculations a target benefit payment value for a current date and for future intervals of an allocation period. Cooperstein also does not teach or suggest the target benefit payment value that represents a target benefit payment to the contract holder should an allocation

component immediately accelerate the allocation period by purchasing the remainder of at least first retirement benefit that is being gradually purchased during the allocation period.

Furthermore, as mentioned, Cooperstein does not consider nor provide for in its processor calculations *the controller adapted to recalculate for each future interval of the allocation period a recalculated total current value and a recalculated target benefit payment value based on at least change information . . . including at least one change to the retirement benefit program specified by the person.*

As described, Claim 55 provides an integrated computer system for planning for, implementing and administering a person's retirement benefit program including at least one guaranteed life-dependent retirement benefit that responds to the person's required or desired changes to the benefit program. The single annuity contract disclosed in Cooperstein is the type of retirement benefit vehicle that is fixed with respect to funding and locks-in a certain value of assets. In this respect, Cooperstein teaches away from the computer system of Claim 55 and takes away the benefits and advantages of the claimed computer system.

(4)   Tyler

Tyler discloses a computer-based system and method for requesting and inputting insurance and investment product information and for performing calculations. Tyler uses the term "insurance product" to include insurance and investment products, such as life insurance, disability income contracts, annuities and mutual funds. (col. 4, line 65 - col. 5, line 6). The system and method include a computer implemented graphical user interface displayed on a computer screen for receiving instructions and information related to insurance products and for displaying an insurance proposal related thereto. (col. 77, lines 2-5). The invention is directed to addressing the inadequacy of prior art systems and methods to request and input information and to perform calculates due to

the complexity of insurance products, the number of product features and components available, and the various product options and time intervals. (col. 4, lines 43-52). Further, the invention addresses the difficulty of present systems and methods to create sales proposals due to the large number of product variations, features or components, the calculations necessary to provide product information, and the variable assumptions used to determine a policy's value. (col. 2, lines 14-21).

The computer implemented graphical user interface of Tyler enables a user to enter intelligently all relevant information about an insurance product regardless of the insurance product or the type of request. The system includes a calculation engine to perform all calculations related to the insurance products. (col. 5, lines 6-10). The graphical user interface is a matrix-like interface referred to as a design grid. The design grid collects information from a user, identifies information needed, and presents choices for a user to select while the user is designing the policy. The design grid also displays information related to the policy, at the policy level and the component level at a "point in time" and over one or more time intervals. (col. 5, lines 33-41).

The design grid includes rows and columns that appear based on the type of product or information entered. A producer can enter information about a policy and the design grid itself can determine what information variables are needed or not relative to the policy being developed. As selections for a policy are made, different choices that result from these selections are displayed, as well as a list of possible options for the policy. The choices available reflect the structure of the insurance products that are "sold" by the insurance company. The design grid also allows an agent to specify the time interval for which information is desired. The grid design therefore standardizes and simplifies the input of information and leads to reduce operator training and errors. (col. 6, lines 10-27). The grid design also eliminates the current prior art systems and methods that include a request screen for each insurance product available. Such traditional request screens have been designed and developed "one field at a time." (col. 1, lines 63-65).

Tyler does not teach or suggest the computer system of Claim 55 for implementing and administering a retirement benefit program to provide a guaranteed

lifetime income to a person. More particularly, Tyler does not teach or suggest at least *the controller of the computer system server* of Claim 55 *adapted to calculate as of a current date: (i) a total current value representative of a sum of a current value of the first retirement benefit purchased to date based on actuarial valuations and a market value of the asset vehicle, and (ii) a target benefit payment value representative of a benefit payment available to the person if the allocation component immediately accelerates the allocation period by executing an allocation of funds corresponding to the total current value towards purchasing a remainder of at least the first guaranteed life-dependent retirement benefit.*

In addition, Tyler does not teach or suggest at least *the controller adapted to calculate for each future interval of the allocation period: (i) a total current value and (ii) a target benefit payment, employing at least relevant portions of the stored financial and statistical information related to future market performance, inflation and interest rates.* The controller calculations including the total current values (the asset vehicle market value added to the retirement benefit current value for a current date and for future intervals of the allocation period), and the target benefit payment values for current and future intervals of the allocation period provide a real-life scenario of the benefit values and the asset investment returns, as well as potential or target benefit payments the person could receive. The controller calculates the values employing relevant financial and statistical information related to future market performance, inflation and interest rates. The person can use these values to gauge whether to continue to purchase gradually the retirement benefit under the current asset allocation or to change the asset allocation, for instance, in view of greater than expected market returns - as represented by the total current value.

Further, Tyler does not teach or suggest the controller *adapted to recalculate for each future interval of the allocation period a recalculated total current value and a recalculated target benefit payment value based on at least change information received from at least the remote client computer including at least one change to the retirement benefit program specified by the person.* As mentioned, the person can use the total current values and target benefit payment values to gauge whether to continue the present

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asset allocation. Should the person decide in view of these values to make a change to the asset allocation and ultimately his/her retirement benefit program (change *information . . . including at least one change to the retirement benefit program specified by the person*), the controller recalculates these values for future intervals of the allocation period to thereby provide a "real-life" scenario and/or a simulation scenario. Such scenarios are "real-life" or simulated depending on whether the person elects to make the change. The scenario is real-life if the person elects to make a change while the scenario can be considered a simulated scenario if the client does not elect to make at least one change.

Claim 55 further recites the limitation the allocation component is *further adapted to alter the allocation of funds towards achieving the recalculated total current values and the recalculated target benefit payments in accordance with at least a second set of instructions including at least information specified by the person based on the at least one change to the retirement benefit program*. The person can elect to make a change in view of the recalculated total current values and the target benefit values of future intervals of the allocation period, and cause the system to alter the asset allocation in *accordance with a second set of instructions based on the at least one change towards achieving the recalculated total current values and the recalculated target benefit payments*. In this manner, the system of Claim 55 enables the person to change the guaranteed lifetime income provided by the at least first guaranteed life-dependent retirement benefit in view of any changing or unexpected circumstances the person experiences. The retirement benefit program in this sense is dynamic and relatively liquid.

The graphical user interface of Tyler therefore does not teach or suggest at least the controller and the allocation component of Claim 55.

With respect to new independent Claims 79 and 80, Tarbox does not teach or suggest the computer system for evaluating and implementing a retirement benefit program to provide a guaranteed lifetime income for at least one person. In particular, Tarbox does not teach or suggest at least one simulation component that is coupled to the

computer system server wherein the simulation component is *adapted to generate a plurality of sample benefit programs in accordance with one or more retirement benefit program choices specified by the person. Each sample retirement benefit program including simulated results. The simulated results include for selected intervals of an allocation period: (i) a simulated total current value ... and (ii) a simulated target benefit payment value.*

These simulated total current values and simulated target benefit payment values for selected intervals of the allocation period are similar to the total current values and target benefit payment values for future intervals of the allocation period discussed above and claimed in independent Claim 55. However, the simulated values are not actual or real-time values but rather are simulated values the simulation component generates in accordance with the one or more retirement benefit program choices the person specifies. The simulated total current values and simulated target benefit payment values, or, in other words, the simulated results, provide the same information regarding the expected income benefit payments or guaranteed lifetime income as do the total current values and target benefit payment values for future intervals of the allocation period of Claim 55 but for a simulated rather than an actual retirement benefit program.

The simulation component of Claim 79 generates these simulated results and the server provides these results to the person for consideration. The simulated results in this context serve as a "what-if" scenario of a sample retirement benefit program for the person to consideration.

In addition, the simulation component of Claim 79 is *adapted to recalculate the simulated total current value and the simulated target benefit payment value for each of selected intervals of the available allocation period . . . based on change information . . . including at least on change to a generated sample retirement benefit program specified by the person.*

Tarbox clearly does not teach or suggest the simulation component of Claim 23 for at least the reasons discussed above.

In addition, the foregoing prior art references do not teach or suggest the simulation component as claimed in Claims 79-80 for at least the same reasons given

above with respect to new independent Claim 55. The simulation component is similar to the controller component with respect to being adapted to calculate and to recalculate, as of a current date and for future intervals of an allocation period, the total current values and the target benefit payment values. The values the simulation component calculates and recalculates are simulated values for one or more sample retirement benefit programs rather than values for an actual retirement benefit program.

Further, the foregoing prior art references do not teach or suggest the method of new Claims 81-94 for at least the same reasons given above with respect to Claim 55.

C.   Nonobviousness of Claims In View of Cited Combinations of Prior Art

In the Office Action dated September 16, 2004, the Examiner rejected the previously pending claims as being unpatentable under 35 U.S.C. § 103(a) over Tarbox or Tyler, as the primary references, in view of a number of cited combinations of secondary references including one or more of Jones, Cooperstein, Barron's Dictionary, Barron's Dictionary of Finance and Investment, Best's Review, Rosenberg, and Brownstone & Franck. As mentioned, Applicant has cancelled herein Claims 1-54 and has added herein new Claims 55-94 to the present application. Applicant respectfully submits new Claims 55-94 are allowable in view of the cited combinations of prior art references for the reasons given above and discussed below.

(1)   Cited Combinations of Prior Art References Do Not Teach Claimed Invention

To establish *prima facie* obviousness of a claimed invention, the prior art must teach or suggest **all** the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In particular, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); *see*, MPEP 2143.03.

Applicant respectfully submits new Claims 55-94 are allowable over the prior art references cited in the September 16, 2004 Office Action because the prior art references, alone or any combination, do not teach or suggest all of the claim limitations of new Claims 55-94 provided herein.

In the Office Action of September 16, 2005, the Examiner rejected previously pending independent claims 1, 14 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Tarbox in view of Tyler, or over Tyler, in view of a number of cited combinations of the secondary references noted above.

The Examiner rejected the claimed methods of previously pending claims 1, 14 and 30, in part, due to Tyler "explicitly teaching" the claimed "total client market value" (recited herein in independent Claims 55, 79 and 81 as *a total current value),* and the claimed "target benefit payment" (recited herein in Claims 55, 79 and 81 as *a target benefit payment value).* The Examiner refers to the Background of the Invention section of Tyler, at column 1, lines 54-58, as providing an explicit teaching or suggestion for the claimed values. Tyler discloses, "An agent will usually wish to show the client many possible proposals, each having various information about a product, such as product and component level premiums, cash values, surrender values, dividend values, and benefit amounts." Applicant respectfully submits the disclosure in Tyler does not explicitly teach, nor provide a suggestion for, at least the limitations of *a controller,* as claimed in Claim 55, and *a simulation component,* as claimed in Claim 79. In addition, Applicant respectfully submits the Tyler disclosure does not explicitly teach, nor provide a suggestion for, at least the limitations of *calculating* and *recalculating the total current values and the target benefit payment values as of a current date and for future intervals of an allocation period,* as claimed in method Claim 81.

More specifically, with respect to Claim 55, the Tyler disclosure does not provide an explicit teaching, nor a sufficient suggestion, that would have made the limitation of *a controller adapted to calculate, and to recalculate . . . based on at least one change to the retirement benefit program, a total current value and a target benefit payment values as of a current date* and *for future intervals of the allocation period* obvious to one having ordinary skill in the art. Further, the Tyler disclosure does not explicitly teach or suggest *the total current values* and *the target benefit payment values* as recited in Claim 55 because the premiums, cash values, surrender values, dividend values, and benefit amounts of various products, e.g., insurance products, Tyler discloses are not the same values as the claimed total current values and target benefit payment values as of a

current date and for future intervals of an allocation period. In addition, the values Tyler discloses do not convey sufficient information that would have rendered the claimed total current values and target benefit payment values obvious to one having ordinary skill in the art. Therefore, new independent Claim 55, and claims that depend therefrom, are not obvious with respect to Tyler and with respect to Tarbox in view of Tyler.

In addition, Tyler, and Tarbox in view of Tyler, plus any combination of the secondary references cited in the September 16, 2004 Office Action (including one or more of Jones, Cooperstein, Barron's Dictionary, Barron's Dictionary of Finance and Investment, Best's Review, Rosenberg, and Brownstone & Franck) would not render obvious at least the limitation of a controller, a simulation component or the total current values and the target benefit payment values, as claimed in Claim 55. None of the secondary references, alone or in any combination, explicitly teach or provide a suggestion for the claimed controller and simulation component, nor for the total current values and the target benefit values, as recited in Claim 55.

Therefore, new independent Claim 55, and claims that depend from Claim 55, are not obvious with respect to Tyler, or with respect to Tarbox in view of Tyler, in any combination of the cited secondary references.

For similar reasons, with respect to Claim 79, the Tyler disclosure does not provide an explicit teaching, nor a sufficient suggestion, that would have made the limitation of *a simulation component adapted to calculate a plurality of sample retirement benefit programs including simulated results including simulated total current values and simulated target benefit payments for selected intervals of the allocation period* obvious to one having ordinary skill in the art. Further, the Tyler disclosure does not explicitly teach or suggest *the simulated total current values* and *the simulated target benefit payment values*, as recited in Claim 79.

In addition, Tyler, and Tarbox in view of Tyler, plus any combination of the secondary references would not render obvious at least the limitation of a simulation component, and the simulated total current values and simulated target benefit payment values the simulation component calculates and recalculates. None of these secondary

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references, alone or in any combination, explicitly teach or provide a suggestion for the claimed limitation and values, as recited in Claim 79.

Therefore, new independent Claim 79, and claims that depend from Claim 79, are not obvious with respect to Tyler, or with respect to Tarbox in view of Tyler, in any combination of the cited secondary references.

With respect to method Claim 81, the Tyler disclosure does not teach or suggest *calculating* and *recalculating as of a current date* and *for future intervals of the allocation period a total current value and a target benefit payment value*, as these values are claimed in Claim 81. The Tyler disclosure states, "An agent will usually wish to show the client many possible proposals, each having various information about a product, such as product and component level premiums, cash values, surrender values, dividend values, and benefit amounts." Applicant respectfully submits Tyler does not teach or suggest the claimed total current values and the target benefit payment values because the claimed values are different from and represent different information and calculations that the values Tyler identifies. Claim 81 therefore is patentable over Tyler, or Tarbox in view of Tyler, with any of the cited combinations of secondary references.

Thus, new independent Claims 55, 79 and 81 are patentably distinct from the prior art references previously cited in the September 16, 2004 Office Action. Claims 56-78, 80 and 82-94 depend from Claims 55, 79, and 81, respectively, and are patentable over the cited references for at least the reasons given above.

(2)   No Suggestion or Motivation To Make Combinations of Prior Art References

As noted above, in the September 16, 2004 Office Action, the Examiner rejected the previously pending claims as being unpatentable over Tarbox, or over Tyler, in view of various cited combinations of the secondary references noted above because the cited combinations of references would have been obvious to one having ordinary skill in the art at the time of the invention. Applicant respectfully submits the Office Action does not identify the motivation to modify the cited references or to combine the references in any of the cited combinations to achieve the invention claimed in Claims 55-94.

In support of the Examiner's conclusion the cited combinations of references would have been obvious to one having ordinary skill in the art, the Examiner cites case law. The cited case law correctly interprets the required motivation or the legal basis to modify or to combine prior art references to achieve a claimed invention. The Examiner cites case law to indicate that references cannot be combined arbitrarily and a reason must exist for one having ordinary skill in the art to make the proposed combination of references. *In re Nomiya*, 509 F.2d 566, 184 USPQ 607, (CCPA 1975). The Examiner also cites case law to indicate that the motivation need not be expressly articulated and that the test for combining references is what the combination of references as a whole would have suggested to one have ordinary skill in the art. *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

In addition, the Examiner cites case law to indicate that references are evaluated by what the reference suggests to one having ordinary skill in the art rather than the specific disclosures of such art. *In re Bozek*, 163 U.S.P.Q. 545 (CCPA 1969). The Examiner points out in the rejection that, in this case, one having ordinary skill in the art is a professional, who is licensed under state and federal statutes, including practitioners known as certified life underwriters and financial planners.

The Examiner further indicates that the motivation for using the references in the cited combinations, and in combination with the knowledge of one having ordinary skill in the art, is strong in view of the teachings of the cited references.

Applicant agrees with the Examiner that prior art references need not explicitly disclose the motivation to combine the references in order for the combination to be obvious. In addition, Applicant agrees with the Examiner prior art references as a whole may suggest the combination to render such combination obvious. However, Applicant respectfully submits that the motivation or reasoning for combining the teachings of the prior art references in the combinations cited in the September 16, 2004 Office Action, and in combination with the knowledge of one having ordinary skill, is neither strong nor supported by the teachings of the references. In particular, Applicant respectfully disagrees with the Examiner that the excerpts from the prior art teachings on which the Examiner relies to make this conclusion demonstrate the motivation for the cited

combinations. Applicant also respectfully submits that such excerpts do not provide the motivation to achieve the claimed invention. More specifically, Applicant respectfully submits that the excerpts are at best insufficient to suggest a reason that would motivate one of ordinary skill in the art to use the teachings in the cited combinations, and in combination with the knowledge of one of ordinary skill.

Obviousness cannot be established by combining the teachings of the cited prior art references to produce the claimed invention absent some teaching, suggestion or incentive supporting the combination. *See, In re Geiger*, 815 F.2d 686, 2 USPQ 2d 1276, 1278 (Fed.Cir. 1987). In addition, an Examiner cannot combine the teachings of prior art references, unless those references include some teaching or suggestion supporting the combination. *In re Fritch*, 972 F.2d 1260, 1266 (Fed.Cir. 1992)(quoting *ACS Hosp. Systems v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed.Cir. 1984)).

In addition, the invention as a whole must be evaluated. It is improper to focus on obviousness of substitutions, instead of on an invention as a whole. *Gillette Co. v. S.C.Johnson & Sons, Inc.*, 16 USPQ 2d. 1983 (Fed.Cir. 1990). ". . . changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee's method and device." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ 2d. 1321 (Fed.Cir. 1990).

The Examiner identifies the following excerpts from the teachings of the prior art references as demonstrating the motivation to combine the references in the cited combinations, and in combination with the knowledge of one having ordinary skill, to achieve the claimed invention. In other words, the Examiner relies on the following teachings to conclude the cited combinations are obvious and provide the motivation to use the teachings to make the claimed invention.

Tarbox, in column 1, lines 6-11, states:

The present invention relates generally to an investment program which includes a system and a method for collecting, monitoring, and directing data from Benefit Plan participants and beneficiaries.

Tyler, in column 1, lines 19-24 and in column 4, lines 57-61, states, respectively:

More particularly, the present invention pertains to a system and method for requesting and entering either quoted or actual information on insurance and investment products, such as, for example, annuity, life and disability insurance and investment products.

A uniform approach is needed, in which one user interface can be used to enter information about all possible products, and where the calculations that are performed are designed based on the operations that take place, not on the underlying product for which the operation is performed.

Jones, in column 2, lines 13-17, states:

In view of the following, what is needed is a financial advisory system that employs advanced financial techniques to provide financial advice to individuals on how to reach specific financial goals.

Cooperstein, in column 1, lines 4-8 and in column 3, lines 6-7, states, respectively:

The present invention pertains generally to the financial field of insurance and more particularly to a computer implemented system for determining certain values in annuity contracts.

There is a need for a system that provides more disclosure of the workings of life annuity contracts so that when the contract is presented to customers they can appreciate and act on all of such contracts' critical components.

Applicant respectfully submits the excerpts noted above are general statements describing the inventions disclosed in the references or the overall objectives of the inventions, and/or are generalizations about the inadequacies of prior art systems and methods or the needs and desires prior art systems and methods fail to provide or meet.

Applicant does not understand how the above excerpts provide the motivation or reasons to use the teachings in the cited combinations, and in combination with the knowledge of one having ordinary skill. In particular, Applicant respectfully submits that neither Tarbox or Tyler, nor any of the cited secondary references, provide a motivation to modify the subject matter of Tarbox or Tyler to achieve the claimed invention of Claims 55-94. In Applicant's August 14, 2004 Amendment, Applicant respectfully requested the Examiner cite the section of either Tarbox or Tyler, or any of the secondary

references, that the Examiner believes provide such a motivation and to state how the cited section provides such a motivation. The Examiner responded to this request in the September 16, 2004 Office Action by citing the above excerpts.

Modifying the system and method disclosed in Tarbox in accordance with the teachings of Tyler or one or more of the secondary references would not lead to the invention claimed in Claims 55-94. Tarbox discloses an investment advice system and method that employs a worksheet to elicit information from a Benefit Plan or 401(k) participant (14) necessary for an investment advisor (32) to recommend an appropriate Trust (20, 22, 24, 26) containing mutual fund shares the participant's 401(k) assets would be used to purchase. Modifying the Tarbox investment advice system and method in accordance with the various potential combinations of teachings that Tyler, Jones, and Cooperstein provide would not achieve the claimed invention. Tyler discloses a graphical user interface to enable a user to enter intelligently into a computer system all relevant information about an insurance product regardless of the insurance product or the type of request. An interactive electronic embodiment of the worksheet of Tarbox relates to the graphical user interface of Tyler with respect to mutual funds. Jones discloses a system that relates, for instance, securities, to a factor model that spans a range of investment products to generate forward-looking investment scenarios that includes a simulation component to provide such scenarios to users. Cooperstein discloses a system and method for determining funding data representing annuity contract values and contract payout values to provide more disclosure of the workings of annuity contracts in order customers can appreciate and act on critical components.

However, no combination of the references would modify the system and method of Tarbox to achieve the claimed invention as a whole because such modifications would not at least achieve the controller and the total current values and the target benefit payments values and the simulation component, as claimed in Claims 55, 79 and 81.

Similarly, modifying the graphical user interface of Tyler using the teachings of any combinations of the references would not achieve the claimed invention as a whole because such modifications would not at least achieve the controller and the total current

values and the target benefit payment values and the simulation component, as claimed in Claims 55, 79 and 81.

In other words, one would not modify the system and method disclosed in Tarbox, or disclosed in Tyler, to achieve the claimed invention but rather one would have to replace significant aspects or limitations of the Tarbox or the Tyler system and method, or replace the Tarbox or the Tyler system and method entirely, to achieve the claimed invention.

Moreover, Applicant respectfully submits that the cited references in any combination, and in combination with the knowledge of a certified life underwriter or financial planner, would not achieve the claimed invention.

It is impermissible for an Examiner to use the claimed invention as a "template" to piece together the teachings of the prior art references to render the claimed invention obvious. *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). An Examiner is not allowed to use hindsight to pick and choose among pieces of prior art references so as to reconstruct the claimed invention. *In re Fritch*, 972 F.2d at 1260, 1266 (Fed.Cir. 1992). The Federal Circuit has observed, "[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *In re Fine*, 837 F.2d 1071, 1075 (Fed.Cir. 1988)(quoting *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)). See also *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 313, 227 USPQ 1923 (Fed.Cir. 1985). Additionally, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fritch*, 23 USPQ 2d 1783-84 (Fed.Cir. 1992).
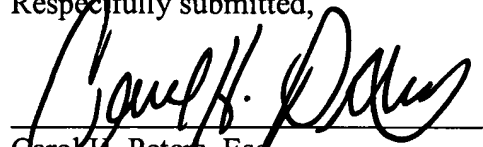
Applicant respectfully submits the prior art is replete with references disclosing a wide range systems and methods that involve numerous and different financial and insurance products and programs which generally relate to the above excerpts of the prior art teachings the Examiner has identified to demonstrate a strong motivation to combine the references. The general statements describing the inventions and their objectives as

well as the inadequacies of prior art systems and methods recited in the excerpts could appear in any reference in the analogous art.

Applicant respectfully submits that in view of: (i) the combination of prior art references cited, (ii) the lack of any motivation, or the insufficient reasons, disclosed in the references to make the cited combinations, and (iii) the inability of any combination of references to achieve the claimed invention of Claims 55-94 as a whole, suggests individual cited references were selectively applied to each of the claimed limitations of previously rejected Claims 1-54. In view of the foregoing discussion, Applicant respectfully submits no combination of the cited prior art references is obvious such that one of ordinary skill in the art would have been motivated to use the teachings of such combinations to make the claimed invention of new Claims 55-94.

Based on the foregoing amendments and discussion, the application is believed to be in condition for allowance, which action is respectfully requested. Should the Examiner have any questions concerning this response, the Examiner is invited to telephone the undersigned attorney at the number provided.

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